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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/830,015	04/23/2004	Byung Jun Mun	YHK-0134	7646

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EXAMINER

MCPHERSON, JOHN A

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/830,015

Applicant(s)

MUN ET AL.

Examiner

John A. McPherson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 and 9-13 is/are allowed.
- 6) ☒ Claim(s) 8 and 14-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the Amendment filed 5/23/05.
2. The Amendment filed 5/23/05 successfully overcomes the rejections set forth in paragraph 1 of the Office Action mailed 2/23/05. Accordingly, this rejection is withdrawn.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 15, 16 and 21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9 and 15-17 of copending Application No. 10/950,665. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are anticipated by (i.e. fully encompass) the claims of the copending

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application. Specifically, the presently claimed invention is drawn to a display fabricating method comprising attaching a prefabricated layer to a substrate, wherein the prefabricated layer comprises a black material and an electrode layer; forming at least one electrode using the black material and electrode layers; and forming at least one black matrix using the black material layer. The copending application comprise a method of manufacturing a plasma display panel comprising laminating a green tape that is fabricated in advance on an upper substrate; consecutively exposing the substrate to different ultraviolet wavelengths; and developing, drying and sintering the exposed green tape, wherein the green tape has a black electrode formed at the bottom and a silver electrode formed at the top.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15-23 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The presently claimed method, which is described as requiring steps critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Claims 15 does not include the steps of aligning a first mask on the front surface of the substrate, aligning a second mask on the rear surface of the substrate, exposing the prefabricated layer using the first and second mask, and developing the prefabricated layer. The disclosure describes these steps as critical and essential to the practice of the invention (e.g. see paragraphs [0021]-[0033] of the specification).

Similarly, claim 23 does not include the steps of providing a sheet into which a black material layer and an electrode material layer are integrated, forming the sheet on the substrate, and developing the layers. The disclosure describes these steps as critical and essential to the practice of the invention (e.g. see paragraphs [0021]-[0033] of the specification).

5. Claims 15-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 15 and 23 are drawn to "a display [i.e. generic] fabricating method", however the specification describes a fabricating method of a plasma panel display, for example see paragraph [0021].

Claims 20 sets forth the limitation "wherein the prefabricated layer is attached to the substrate with at least one of a temperature of around 50-80°C and pressure around 1.5 kg/cm²", however at paragraph [0044] the specification describes laminating the

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sheet to the substrate “with a temperature of around 50-80°C and the pressure of around 1.5. kg/cm²” (i.e. the specification teaches meeting both conditions, not only at least one of the conditions). Similarly, claim 22 sets forth the limitation “wherein the lamination occurs in at least one of a temperature of around 70-90°C and pressure around 3-4 kg/cm²”, however at paragraph [0052] the specification describes laminating the black material layer with the electrode material layer “with a temperature of around 50-80°C and the pressure of around 3-4 kg/cm²”.

Claims 23 sets for the limitation forming at least one black material layer and at least one electrode material layer on a substrate”, however the specification describes providing a black material layer (i.e. singular) and an electrode layer (i.e. singular). For example, see paragraph [0022] of the specification. The disclosure does not describe providing more than one of each layer, as would be included in the presently claimed “at least one” embodiment.

Furthermore, claim 23 sets forth the limitation “aligning a second mask with a second side of the substrate and exposing the electrode material layer”, however at paragraph [0046] the specification describes aligning a second photo-mask on the rear surface and exposing the black material layer.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8 refers to "a black matrix" in line 3-4. It is not clear if this is a reference to the light shielding layer formed in claim 1 (line 10), or if this is intended to be an additional element. This rejection could be overcome by amending "a black matrix" to -- the light shielding layer-- in claim 8, lines 3-4.

Claim 14 recites the limitation "the black matrix layer" in line 1. There is insufficient antecedent basis for this limitation in the claim. This rejection can be overcome by amending "black matrix layer" to -- light shielding layer--.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15, 16, 19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6,156,433 (US '433). US '433 discloses a process for producing an electrode of a plasma display panel comprising the steps of transferring a photosensitive black conductive paste layer and a photosensitive conductive paste layer onto a substrate using a transfer sheet, exposing the photosensitive black conductive paste layer and the photosensitive conductive paste layer through a mask, and

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developing the exposed photosensitive black conductive paste layer and the exposed photosensitive conductive paste layer, wherein the black conductive paste layer functions as a black matrix. See column 4, lines 11-17 and column 14, lines 1-13.

Allowable Subject Matter

8. Claims 1-7 and 9-13 allowed.
9. Claims 8 and 14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments with respect to claim 8 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. McPherson whose telephone number is (571) 272-1386. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).



John A. McPherson
Primary Examiner
Art Unit 1756

JAM
7/28/05